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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

MCCARTHY, J. L. T.

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/167,351

Applicant(s)

Haaf et al.

Examiner

McCarthy, T.C.

Group Art Unit

1618



☒ Responsive to communication(s) filed on Oct 7, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-15 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a process for preparing compounds, classified in class 436, subclass 523.
- II. Claims 10, drawn to a compound, classified in class 514, subclass 42.
- III. Claim 11, drawn to a library, classified in class 514, subclass 42.
- IV. Claim 12 and 13, drawn to a library, classified in class 514, subclass 42.
- V. Claim 14, drawn to an assay, classified in class 435, subclass 7.1+ (depending on the compound and assay).
- VI. Claim 15, drawn to an assay, classified in class 435, subclass 7.1+ (depending on the compound and assay).

Inventions I and II-V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP ' 806.05(f)). In the instant case, the product can be made using any number of known synthesis methods (i.e. solid phase synthesis using light-generated reagents, classical serial synthesis, etc.).

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Inventions I and VI-VII are different. The steps required to make a compound are different from those required to assay a compound for activity, and the processes are practiced for different purposes. Therefore, art reading on one invention would not read on the other – absent ancillary art – and the restriction requirement is proper.

Inventions II and III-V are different. A library is by definition 2 or more, and is therefore distinct from a single compound. Furthermore libraries are used for different purposes (i.e. screening) than are single compounds. Therefore, art reading on one invention would not read on the other, and the restriction between II and III-V is proper.

Inventions II and VI-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP '806.05(h)). In the instant case, the product can be used as a scaffold upon which other compounds can be built/synthesized.

Inventions III-V are different, each one from the others. The library of inventions III-V each contain different compounds from the other libraries. These compounds have different structures and functionalities, and art reading on one library would not read on the other – absent ancillary art. Restriction requirement between invention III and IV and V is therefore proper.

Inventions II and VI-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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as claimed can be used in a materially different process of using that product (MPEP '806.05(h)). In the instant case, the processes of inventions VI and VII can be practiced using any libraries of any compounds.

Inventions VI and VII are different. The assay of invention VI is practiced using a library that contains different structures/functionalities than the library used to practice invention VII. Therefore, different reagents are necessary to practice the process, and different compounds will be identified using these assays. Art reading on one library would not read on the other – absent an ancillary reference.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. However, some of the above distinct inventions may fall within the same class and subclass. In these cases, restriction is also proper because of the reasons listed above, and because these inventions have acquired a separate status in the art due to their recognized divergent subject matter.

Election of Species

Should the applicant elect invention I, an election is also required with respect to the following patentably distinct species in the claimed invention: compounds, resins, and process for preparing the compounds (claims 2-9). Each of these compounds and resins have different

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structures and functional groups, and each of the processes uses different reagents and arrives at different products. Therefore, a reference reading on one would not render the others obvious. Applicants are required to elect a single compound (i.e. where all functionalities are defined), a single resin on which the compound is to be prepared, and a single process by which the compound is prepared. Furthermore, the wording of claims 1-9 is convoluted, at times the grammar is erroneous, and the type setting is disjointed (i.e. step (a) of claim 1). The examiner had an inordinately difficult time interpreting the claims, and requests that the applicant fix claims 1-9 such that they are easier to read and understand. Furthermore, the examiner requests that when the applicant elects a compound, resin, and the associated process for making the product, that it be worded in such a way that anyone of ordinary skill in the art can easily understand it.

Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP ' 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to William F. Lawrence on November 1 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.C. McCarthy whose telephone number is (703) 308-5316. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, can be reached on (703) 308-0570.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

September 28, 1999

T.C. McCarthy III, Ph.D.


KEITH D. MacMILLAN
PRIMARY EXAMINER